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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,054	01/25/2002	Karl Schneck	3699-12	3424
22442	7590	02/10/2005	EXAMINER	
SHERIDAN ROSS PC 1560 BROADWAY SUITE 1200 DENVER, CO 80202			HUBER, PAUL W	
			ART UNIT	PAPER NUMBER
			2653	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/057,054	Applicant(s) SCHNECK ET AL.	
	Examiner Paul Huber	Art Unit 2653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date (<u>11 sheets</u>). | 6) <input type="checkbox"/> Other: ____. |

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The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claims 1-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 34-52, respectively, of U.S. Patent No. 6,747,930. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims include each and every limitation of the application claims and it would have been obvious to one having ordinary skill in the art to modify the invention defined by the patent claims such that the limitations not found in the application claims are removed from the patent claims to arrive at the invention defined by the application claims. One of ordinary skill in the art would have been motivated to do this for the purpose of simplifying the device thereby making the device less complicated and expensive to manufacturer.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19 would be allowable if a terminal disclaimer is timely filed as required above.

The following is an examiner's statement of reasons for allowance: the prior art of record considered as a whole fails to teach or suggest either:

1) a method for creating physical defects on an optical disc for identifying the optical disc, comprising: receiving source signals of data to be encoded onto the optical disc, **combining a representation of the source signals with one or more defective codes; encoding the representation having the defective codes onto the optical disc so that sites of the optical disc having encodings of the defective codes are capable of generating one or more errors when the optical disc is read by an optical reader, wherein the one or more errors are capable of being identified for identifying the optical disc;** or

2) a method for creating physical defects on an optical disc for identifying the optical disc, comprising: receiving a source signal of data to be encoded onto the optical disc, encoding a representation of the source signals

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onto a master optical disc, **purposefully damaging the master optical disc for providing one or more defective data areas, transferring data from the master disc to the optical disc, the optical disc including one or more corresponding data areas corresponding to the one or more defective data areas of the master optical disc, wherein when the corresponding data areas are read by an optical reader, one or more errors are generated that are capable of being identified for identifying the optical disc; or**

3) a method for creating physical defects on an optical disc for use in identifying the optical disc, comprising: transferring data from a master optical disc to the optical disc; determining one or more areas of the optical disc having data thereon; **purposefully damaging the one or more areas so that when the areas are read by an optical reader, read errors are generated that are capable of being identified for identifying the optical disc; or**

4) a method for creating physical defects on an optical disc for identifying the optical disc, comprising: receiving a source signal of data to be encoded onto the optical disc, encoding a representation of the source signals onto a master optical disc, creating a metal part or a series of metal parts from the master optical disc, **purposefully damaging the metal part for providing one or more defective data areas, transferring data from the metal part to the optical disc, the optical disc including one or more corresponding data areas corresponding to the one or more defective areas of the master optical disc, wherein the corresponding data areas are read by an optical reader, one or more errors are generated that are capable of being identified for identifying the optical disc; or**

5) an apparatus for creating physical defects on an optical disc, comprising: means for receiving source signals of data to be encoded onto the optical disc, **means for combining a representation of the source signals with one or more defective codes; means for encoding the representation having the defective codes onto the optical disc so that sites of the optical disc having encodings of the defective codes are capable of generating one or more errors when the optical disc is read by an optical reader, wherein the one or more errors are capable of being identified for identifying the optical disc; or**

6) an apparatus for creating physical defects on an optical disc, comprising: means for receiving a source signal of data to be encoded onto the optical disc, means for encoding a representation of the source signals onto a master optical disc, **means for purposefully damaging the master optical disc for providing one or more defective data areas, means for transferring data from the master disc to the optical disc, the optical disc including one or more corresponding data areas corresponding to the one or more defective data areas of**


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the master optical disc, wherein when the corresponding data areas are read by an optical reader, one or more errors are generated that are capable of being identified for identifying the optical disc; or

7) an apparatus for creating physical defects on an optical disc, comprising: means for transferring data from a master optical disc to the optical disc; means for determining one or more areas of the optical disc having data thereon; **means for purposefully damaging the one or more areas so that when the areas are read by an optical reader, read errors are generated that are capable of being identified for identifying the optical disc; or**

8) an apparatus for creating physical defects on an optical disc, comprising: means for receiving a source signal of data to be encoded onto the optical disc, means for encoding a representation of the source signals onto a master optical disc, means for creating a metal part or a series of metal parts from the master optical disc, **means for purposefully damaging the metal part for providing one or more defective data areas, means for transferring data from the metal part to the optical disc, the optical disc including one or more corresponding data areas corresponding to the one or more defective areas of the master optical disc, wherein the corresponding data areas are read by an optical reader, one or more errors are generated that are capable of being identified for identifying the optical disc.** (bold language emphasized)

Any inquiry concerning this communication should be directed to Paul Huber at telephone number 703-308-1549.


Paul Huber
Primary Examiner
Art Unit 2653

pwh
February 8, 2005